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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/469,993

12/22/1999

SHERYL BEHAR

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5639

31013

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10/20/2006

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/469,993

Applicant(s)

BEHAR ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8, 11, 13-17, 19-22, 27, 30, 32-36, 38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 11, 13-17, 19-22, 27, 30, 32-36, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, Applicant's submission filed on Aug 28, 2006 has been entered. No amendment to the claims were made. Claims 1-3, 8, 11, 13-17, 19-22, 27, 30, 32-36, 38 and 39 remain pending. Claims 1, 20, 39 are independent.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-3, 8, 11, 13-17, 19-22, 27, 30, 32-36, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker, US 6018718 A.**

As to claims 1, 8, 11, 20, 27, 30, 39, Walker discloses the prior art of giving rewards based on qualifying purchases (see at least col. 1 line 1 to col. 3 lines 7: e.g. col. 1 lines 34-37: Discover card's qualifying purchases made using the card), and further discloses computerized

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method and system to distribute those rewards (see at least Figs. 1-5 and associated text). Thus it is obvious from a combination of those teachings that Walker discloses the claimed invention as follows for the advantage of allowing automating the prior art of distributing rewards based on qualifying purchases.

Thus Walker discloses:

A computerized method for providing a credit card rebate to a credit card holder rewarding the card holder for use of the credit card, comprising the steps of:

providing a data-processing computer including a database storing holder ID, current balance (see at least Figs. 1-5 and associated text);

retrieving information associated with one or more purchases made by a credit card holder using a credit card issued from an issuer to said holder, said credit card representing an available line of credit from said issuer for said holder and providing means for said issuer to settle said credit card purchases of said holder (see at least col. 1 line 1 to col. 3 line 7);

storing said credit card purchase information in said database (see at least Figs. 1-5 and associated text);

determining using said computer whether ones of said credit card purchases comply with a set of pre-defined program rules, said pre-defined program rules including objective criteria by which said holder is provided with a rebate reward based on the purchase using said credit card of at least one of goods and services of any provider of goods or services regardless of whether there is a co-branding relationship between said issuer and said provider associated with said credit card (see at least col. 1 line 1 to col. 3 lines 7);

calculating a rebate reward credit for each of said ones of said credit card purchases determined to be in compliance with said pre-defined program rules, said rebate reward credit based on at

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least a portion of the associated one of said credit card purchases that comply with said pre-defined program rules;

maintaining an automatically updated tally of rebate reward credits in said database, and

automatically paying a rebate from said issuer to said holder based on said tally without restriction of said holder and said provider (see at least col. 1 lines 26-28 = automatic periodic disbursements), said rebate payment not affecting any point-of-sale credit card purchases of said holder (see at least col. 1 lines 26-28: cash payments).

As to "said rebate reward payment not exceeding a maximum threshold amount preselected by said issuer" Official Notice is taken that it is well-known to give gifts (a fixed amount) or predetermined amounts of rewards, which effectively is a reward cap . WALKER discloses periodic rebate payments. It would have been obvious to one skilled in the art at the time the invention was made to add maximum rewards to Walker's periodic reward payments in order to limit the contributors costs.

As to claims 2, and 21, the claim language is interpreted as meaning the rebate payment is less than a portion of either (i) one of the qualifying purchases or (ii) the rebate tally due to the use of " at least one of". Walker inherently discloses the rebate payment being less than the reward tally (it is inherent that the system would not pay more reward than what has been earned).

As to claims 3, 22, WALKER discloses one or more credit card transactions include purchase transactions (see at least col. 1 lines 20-36), and said rebate credits are based on one of (i) a fixed percentage of the sum of all ones of said credit card purchase (see at least col. 1 lines 20-36).

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As to claims 13, 32, WALKER discloses a qualifying transaction is a balance transfer (see at least col. 6 line 29), and the reward amount is based on a portion of the qualifying transaction (see at least col. 1 lines 35-36) thus "said rebate tally including at least a portion the transfer of credit balances of said holder to said current balance" would have been obvious as another way of calculating rewards and encouraging use of the credit card.

As to claims 14-15, 33-34, WALKER discloses reward points issued on the credit card, in response to qualifying purchases and further discloses the payout as a later payout, applied to purchases of other qualifying goods/services (see at least col. 1 lines 30-37: big ticket items) including car purchases from any manufacturer (GM is any manufacturer).

As to claims 16 and 35, Walker does not disclose pre-defined program rules requiring said holder to provide a sales receipt and a change of title of said car to said issuer. However adding such requirements to Walker would have been obvious to prevent fraud and verify actual purchase of a car. It is well-known to present sales receipts to show actual purchases. It is also well-known to change the title of a car to the finance issuer when a car purchase is being financed.

As to claims 17 and 36, Walker does not disclose a second credit card issued by said issuer to a second holder to effect one or more credit card transactions, said credit card transactions of said second holder being added to said rebate tally. However, aggregating qualifying purchases of several member of a group such as a household for the purpose of qualifying of rewards is well-known and thus it would have been obvious to one skilled in the art at the time the invention was made to add to Walker issuing a second credit card issued by said issuer to a second holder to effect one or more credit card transactions, said credit card transactions of said second holder being added to said rebate tally so to encourage use for the credit card by many members of the group and thereby increase the issuer's revenues.

As to claims 19 and 38, WALKER discloses said rebate is in the form of at least one of a check forwarded to said holder from said issuer (see at least col. 1 lines 29-36).

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive. No amendment to the claims was made, thus the previous rejection stands. Applicants main argument is that Walker teaches away (Response at page 10, 12).

However, it is well-settled, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843 (CA FC 1989). Further, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 169 USPQ 423 (CCPA 1971).

Here, the particular Walkers's teaching that Applicants argue against, i.e. rewards based on achieving performance targets, etc.. (see Response at pages 11-12) was not the basis for the rejection. What was relied upon was the prior art discussed in Walker, mainly "the prior art of giving rewards based on qualifying purchases (see at least col. 1 line1 to col. 3 lines 7: e.g. col. 1 lines 34-37: Discover card's qualifying purchases made using the card", and also the GM card where rewards are based on " transactions completed based on the GM master card" (i.e. "qualifying transactions") (see Walker col. 1 lines 38-46). These rewards are "based on predetermined objective criteria" (Walker, col. 1 lines 48-49), which are exactly the same as Applicant's invention (see Response, page 12, 2nd full paragraph).

The next teaching of Walker relied upon was the computerized method for distributing the rewards , which include e.g. having a database of account ID's , account balances, and other criteria needed to calculate the rewards . Thus it was stated earlier "

"As to claims 1, 8, 11, 20, 27, 30, 39, Walker discloses the prior art of giving rewards based on qualifying purchases (see at least col. 1 line1 to col. 3 lines 7: e.g. col. 1 lines 34-37: Discover card's qualifying purchases made using the card), and further discloses computerized method and system to distribute those rewards (see at least Figs. 1-5 and associated text). Thus it is obvious from a combination of those teachings that Walker discloses the claimed invention as

follows *for the advantage of allowing automating the prior art of distributing rewards based on qualifying purchases.*

In other words, it is irrelevant that Walker teaches a much more complex formula for calculating rewards. The prior art (Discovery Card, GM card) discussed in Walker already teaches a simpler formula for calculating rewards based on straight forward qualifying transactions, just as claimed. Since Walker's computerized method can calculate and distribute rewards based on a more complex formula, it would have been obvious the same computerized method would be applicable to calculate and distribute rewards based on a simpler formula such as used in Discovery Card or GM card. All that is needed is to change the formula which computers are well adapted to handle.

Applicants also argue its invention avoids the need for conventional partnerships or co-branding with provider of goods (Response at page 11). It is noted the claim language is

"..regardless of whether there is a co-branding relationship between said issuer and said provider associated with said credit card". This phrase allows co-branding contrary to argument. Further neither the Discover Card nor the GM card requires co-branding to earn the rewards, they are both based on qualifying purchases or transactions made on the card.

Conclusion

5. This is a request for continued examination under 37 CFR 1.114. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 16, 2006


KHL


RAQUEL ALVAREZ
PRIMARY EXAMINER